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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/855,385	05/15/2001	Jheroen P. Dorenbosch	PF02177NA	8937
23447	7590	10/22/2003	EXAMINER	
MOTOROLA INC 5401 NORTH BEACH STREET MAILSTOP E230 FORT WORTH, TX 76137			MEHRPOUR, NAGHMEH	
			ART UNIT	PAPER NUMBER
			2686	4
DATE MAILED: 10/22/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/855,385	Applicant(s) Dronbosh et al.	
	Examiner Naghmeh Mehrpour	Art Unit 2686	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.

- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.

- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.

- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on Jul 18, 2003

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-12 and 14-20 is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-12 and 14-20 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some* c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

4) Interview Summary (PTO-413) Paper No(s). _____

5) Notice of Informal Patent Application (PTO-152)

6) Other: _____

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Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. **Claims 1-2**, are rejected under 35 U.S.C. 102(e) as being anticipated by Aravamudan et al. (US Patent Number 6,301,609 B1).

Regarding **claims 1-2**, Aravamudan teaches a method of emerging Instant Messaging (col 2 lines 60-63), comprising:

causing a mobile subscriber to register with an instant message system prior to participating in an instant message session (col 5 lines 5-9),
indicating availability of the mobile subscriber to buddies of the mobile subscriber (col 7 lines 1-8),

receiving an instant message intended for the mobile subscriber from one of the buddies (col 5 lines 25-31), and

dropping the instant message intended for the mobile subscriber from the one of the buddies if the mobile subscriber does not receive the instant message after the instant message is resent a predetermined number of times (col 7 lines 63-67).

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Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. **Claims 3-5, 7,** are rejected under 35 U.S.C. 103(a) as being unpatentable over Aravamudan et al. (US Patent Number 6,301,609 B1).

Regarding **claim 3**, Aravamudan teaches a mobile subscriber instant message system, comprising;

an instant proxy for receiving registration information from a mobile subscriber and for subsequently indicating to registered system subscribers participating in an instant message session that the mobile subscriber is available for receiving instant messages (col 2 lines 31-38), Aravamudan allows for a high degree of control to be retained by the user, through the user of instant Messaging, to direct delivery of data and communications (col 9 lines 34-45). For example upon notification of a pending event of received data or communications by the communication service platform, the user may select to reject communication or to have data forwarded to Messaging system or elect to conference parties (col 11 lines 35-45). Aravamudan does not teach the instant Messaging proxy resending an instant message intended for the mobile subscriber if the subscriber received no response. However Examiner takes official notice that

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since Aravamudan teaches high level of control retained by the user. Therefore, it have been obvious to one of ordinary skill in the art at the time of the invention to program the system that the instant proxy resend another message if a buddy send a message and not received any response from the mobile, in order to provide more accurate system by resending the second messages, when there is not a response.

Regarding **claims 4-5**, Aravamudan teaches a mobile subscriber instant message system wherein the instant message proxy is located an instant message server (See figure 1, numerals 120, 130), and the instant message proxy is located in proximity a mobile system gateway (See figure 1, numerals 130, 126).

Regarding **claim 7**, Aravamudan teaches a mobile subscriber instant message system further comprising a log in server with which the mobile subscriber must register prior to participating in an instant message session, the log in server for indicating to the registered system subscribers participating in the instant message session that the mobile subscriber is available for receiving instant messages (col 7 lines 33-37, col 8 lines 56-63).

5. **Claim 6**, is rejected under 35 U.S.C. 103(a) as being unpatentable over Aravamudan et al. (US Patent Number 6,301,609 B1) in view of Drottar et al. (US Patent Number 6,333,929 B1).

Regarding **claim 6**, Aravamudan teaches a mobile subscriber instant message system wherein the instant message proxy (col 2 lines 32-38, col 7 lines 41-49). Aravamudan fails tot each that Proxy includes at least one of a timer and a counter programmed to limit the instant message

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from being sent to the mobile subscriber for at least one of only the predetermined number of times and within a predetermined time period. However Drottar teaches a timer and a counter programmed to limit the message from being sent to remote device for the predetermined number of times and within a predetermined time period (col 9 lines 40-50). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine Drottar method with Aravamudan, in order to enhance the system performance by providing more accuracy.

6. **Claims 8-20**, are rejected under 35 U.S.C. 103(a) as being unpatentable over Aravamudan et al. (US Patent Number 6,301,609 B1) in view of Mawhinney (US Patent Number 6,091,710).

Regarding **claims 8-9, 17, 19-20**, Aravamudan teaches a method of a service providers client access to one or more plurality of client premises equipments (CPE) 140, the CPE can be a wireless phone, and service provider can be PSTN. Communications and data can be exchange between the CPE and PSTN via switch module 124 or routing module 122 (see figure 1). An Instant Messaging system is utilized to provide new and useful features and services for clients (col 4 lines 54-64). A communication service platform (CSP) is registered with the IM server as a “buddy” to the subscriber client. The location of subscribers CPE is located by the CPS 160, the CPS initiates communications to the subscribing client via instant messages, and the CPS solicits a response from the subscribers CPE (col 5 line 15-31). The method comprising: notifying the mobile subscriber when instant message parameters reach a predetermined limit (col 10 lines 23-

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31). When the subscribers are off line, all others (buddies) who have identified the user as a buddy are notified that the user is not online and is not available (col 10 lines 11-15). Aravamudan fails to teach that queuing instant messages intended for the mobile subscriber while the mobile subscriber is not registered with the instant message system, and facilitating connection of the mobile subscriber to the instant message system to enable the mobile subscriber to retrieve the queued instant messages. However Mawhinney teaches a method of reducing data queuing instant messages intended for data packets that are transmitted in accordance with Internet protocol (abstract).TCP is utilized at the transport layer to provide flow control utilizing message acknowledgments (col 8 lines 19-20). Three nodes are illustrated in Figure 4, an upstream node 160 (Mobile unit), and intermediate node, which also provide queuing function, or a down stream node 162, and a destination node end-point 164 (Instant Messaging) (col 9 lines 30-35). The intermediate node 162 (queuing function) is capable of identifying acknowledgments from the end point 164 (Instant Messaging) by the information contained in the TCP header. In figure 5, shows five messages have been transmitted by the upstream node (Mobile Unit) without receiving acknowledgments from queuing. The upstream 160 (Mobile unit) waits to receive acknowledgments, thereafter transmits messages on a one-to-one basis. Once limit of queuing is reached maximum, then Mobile would not transmit further message until another message (acknowledgments) is received. Another word the intermediate node (Mobile Unit) starts transmitting messages to IM service when the queuing is reached to Maximum number. For example upon max transmission of seven (n=5), having received only

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four acknowledgments, the upstream nodes (Mobile units) waits receipt of the fifth acknowledgment (col 10 lines 32-65). Then when the maximized Queuing is reached, Mobile starts establishing connection between mobile subscriber and instant message service. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine Mawhinney method with Aravamudan, in order to establish connection between Mobile unit and Instant Messaging service while avoiding excess queuing message for IM (col 11 lines 35-45). Aravamudan allows for a high degree of control to be retained by the user, through the user of instant Messaging, to direct delivery of data and communications. For example upon notification of a pending event of received data or communications by the communication service platform, the user may select to reject communication or to have data forwarded to Messaging system or elect to conference parties. The combination of Aravamudan and Mawhinney does not teach a method wherein notifying the mobile subscriber when **a buddy sends a second message intended for the mobile subscriber subsequent to sending a first unanswered message, the second message being different from the first unanswered message.** However, Examiner takes official notice that since Aravamudan teaches high level of control retained by the user. Therefore, it have been obvious to one of ordinary skill in the art at the time of the invention to program the system wherein when **a buddy sends a second message intended for the mobile subscriber subsequent to sending a first unanswered message, the second message being different from the first unanswered message,** in order to provide more

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accurate system by resending the different message, when there is no response to the prior message.

Regarding **claims 10-12, 14-15**, Aravamudan does not specifically mention that notifying the mobile subscriber when queued instant message parameters reach a predetermined limit comprises notifying the mobile subscriber when a predetermined number of buddies send messages intended for the mobile subscriber within a predetermined amount of time. However Mawhinney teaches the notifying the mobile subscriber when queued instant message parameters reach a predetermined limit (col 11 lines 1-9 and abstract) comprises notifying the mobile subscriber when a predetermined number of buddies send messages intended for the mobile subscriber within a predetermined amount of time (col 10 lines 42-65). Mawhinney teaches that once the system threshold has reached, for example the system threshold is five, five messages have been transmitted by upstream node, without receiving acknowledgments the upstream node waits to receive acknowledgment, (waiting times is the predetermined times). The five messages are queued for a certain amount of time (waiting period) till an acknowledgment received, and thereafter transmits messages. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use Mawhinney teaching to Aravamudan, in order to improve the performance by better bandwidth utilization.

Regarding **claim 16**, Aravamudan fails to teach a method wherein the predetermined limit in the notifying the mobile when queued instant message parameters reach a predetermined limit is based at least in part on mobile subscriber-based instructions. However Mawhinney teaches the notifying the mobile subscriber when queued instant message parameters reach a predetermined

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limit (col 11 lines 1-10) comprises notifying the mobile subscriber when a predetermined number of buddies send messages intended for the mobile subscriber within a predetermined amount of time (col 10 lines 42-65). Mawhinney teaches that once the system threshold has reached, for example the system threshold is five, five messages have been transmitted by upstream node, without receiving acknowledgments the upstream node waits to receive acknowledgment, (waiting times is the predetermined times). The five messages are queued for a certain amount of time (waiting period) till an acknowledgment received, and thereafter transmits messages. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use Mawhinney teaching to Aravamudan, in order to improve the performance by better bandwidth utilization.(col 7 lines 35-44, col 9 lines 1-5).

Regarding **claim 18**, Aravamudan fails to teach a method further comprising downloading the queued instant messages intended for the mobile subscriber when one of a high priority instant message is received and the mobile subscriber sends an outgoing message. However Mawhinney teaches a method comprising: downloading the queued instant messages intended for the mobile subscriber when one of a high priority instant message is received and the mobile subscriber sends an outgoing message (col 2 lines 25-36, col 10 lines 42-65). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use Mawhinney teaching to Aravamudan, in order to achieve better bandwidth utilization, and provide better feasibility for the system.

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Response to Arguments

7. Applicant's arguments filed 7/18/03 have been fully considered but they are not persuasive.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a buddy that sends multiple message without regard for whether an answer is received) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to the applicant's argument that the reference fails to teach that "notifying the mobile subscriber when a buddy sends a second message intended for the mobile subscriber subsequent to sending a first unanswered message, the second message being different from the first unanswered message. Aravamudan allows for a high degree of control to be retained by the user, through the user of instant Messaging, to direct delivery of data and communications. For example upon notification of a pending event of received data or communications by the communication service platform, the user may select to reject communication or to have data forwarded to Messaging system or elect to conference parties or to make new calls or set it up that buddy to send another message (col 9 lines 35-44, col 11 lines 35-45). However, user can program his mobile phone if buddy sends a second message intended for the mobile subscriber subsequent to sending a first unanswered message, the second message being different from the

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first unanswered message. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the above teaching to the combination of Aravamudan and Mawhinney, in order to provide more accurate system by resending the second messages, when there is not a response.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. **Any responses to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 872-9314, (for formal communications indented for entry)

Or:

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(703) 308-6306, (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II. 2121 Crystal
Drive, Arlington, Va., sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding
should be directed to the technology Center 2600 Customer Service Office whose telephone
number is (703) 306-0377.

Any inquiry concerning this communication or earlier communication from the examiner
should be directed to Melody Mehrpour whose telephone number is (703) 308-7159. The
examiner can normally be reached on Monday through Thursday (first week of bi-week) and
Monday through Friday (second week of bi-week) from 6:30 a.m. to 5:00 p.m.

If attempt to reach the examiner are unsuccessful the examiner's supervisor, Marsha
Harold-Banks be reached (703)308-5576.

NM

Oct 20, 2003

Marsha D Banks-Harold
MARSHA D. BANKS-HAROLD
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600